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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,102	01/18/2002	Norman G. Anderson	2315-150	9065

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EXAMINER

LU, FRANK WEI MIN

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 09/11/2002

*6*

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/050,102	ANDERSON ET AL.	
	Examiner	Art Unit	
	Frank W Lu	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 August 2002.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-56 is/are pending in the application.

4a) Of the above claim(s) 1-51 and 54-56 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 52 and 53 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 1/10/2002 (original) is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1)  Notice of References Cited (PTO-892)

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group II, claims 52 and 53 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that: (1) "all of the claims should be examined together because claim 52 is simply claim 1 with some additional steps, and thus references pertaining to them both will necessarily be classified together, or at least cross-references to one another."; and (2) "all three election of species are improper for the elected claims because the elected claims are not concerned with the issues and limitations in the election of species.", and "[S]earching one species involves inherently searching all other species and thus the consideration of these ought to be no undue burden.".

After carefully considering applicant's arguments, the examiner agreed that "all three election of species are improper for the elected claims because the elected claims are not concerned with the issues and limitations in the election of species." and species election will not be apply to Group II. However, these arguments have not been found persuasive toward the withdrawal of the restriction requirement nor persuasive toward the relaxation of same such that Groups I and II will be examined together. First, claim 52 is not simply claim 1 with some additional steps. The phrase "wherein said lower region has a sufficiently small bore to hold an air bubble in it" as recited in claim 52 is a structural characteristic of a centrifuge tube, which is not found in the centrifuge tube as recited in claim 1. Second, the examiner agreed with applicant that both Groups may have the same classifications but note that restriction made by the examiner in last office action is not based on classifications of Groups I and II. Third, since

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species election made by the examiner was based on the structural characteristic of the centrifuge tube as recited in claim 1, searching one species can not involve inherently searching all other species. For example, a search for an ultracentrifuge tube wherein its upper region, middle region and lower region have outer diameters equal to each other as recited in claims 11 and 29 will be different from a search for a ultracentrifuge tube wherein its upper region have outer diameter larger than an outer diameter of lower region as recited in claims 12 and 30.

Therefore, the requirement is still deemed proper and is therefore made FINAL.

***Claim Objections***

2. Claim 52 is objected to because of the following informalities: “a closed bottom.” in line 9 should be “a closed bottom”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 52 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 52 is rejected as vague and indefinite over the phrase “wherein said lower region has a sufficiently small bore to hold an air bubble in it within an aqueous solution below it and in

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the middle region" because it is unclear what it intended. For example, does this phrase mean that said lower region has a sufficiently small bore to hold an air bubble within an aqueous solution of the lower region (see Figure 9) or this phrase mean something else? Please clarify.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 52 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23 of U.S. Patent No. 6,340,570 B1. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the examined claims in this instant application is either anticipated by, or would have been obvious over, the reference claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). Note that, although claim 52 in this instant application is not identical to claim 23 of U.S. Patent No.6,340,570 B1, claim 23 of U.S. Patent No.6,340,570 B1 are directed to the same subject matter and fall entirely within the scope of claim 52 in this instant application. In other words, claims 52 in this instant application is anticipated by claim 23 of U.S. Patent No. 6,340,570 B1.

### ***Conclusion***

7. No claim is allowed.

8. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the patent Analyst of the Art Unit, Ms. Chantae Dessau, whose telephone number is (703) 605-1237.

Frank Lu  
September 6, 2002



W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600